

RECEIVED
CENTRAL FAX CENTER

JUL 23 2007

REMARKS

Applicants have amended the Claims as recited above and have added new Claims 23-26. Support is found in the claims as originally drafted and in the specification as originally drafted. No new matter has been added.

The Examiner has rejected Claim 16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 17 of copending Application No. 10/521,416. The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reason: Claim 17 of the copending Application is directed to a foam control composition comprising a polydiorganosiloxane, a hydrophobic filler having a specific particle size, a non-polar polyol ester, which obviously read on the instant claim of the present invention. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants, through the present amendment, have distinguished the instant invention from copending Application No. 10/521,416. Therefore Applicants have overcome the rejection and respectfully request the Examiner to withdraw the rejection.

Claim Rejections - 35 USC § 112

Claims 1-11 and 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner states that in Claims 1 (page 3, line 14) and 3 (page 3, line 21), "substantially fully esterified" causes confusion because if there are un-esterified hydroxyl groups in the polyol, the resulting polyol ester will not be non-polar. Furthermore, the Examiner states that it is not clear as to what extent of the polyol being esterified in order to be called "substantially" fully esterified. Especially, the Examiner notes that if the polyol is not fully esterified, it is not clear as to the difference between these substantially fully esterified polyol esters and the polyol ester having unesterified -OH group recited in Claim 7.

Applicants have amended Claims 1 and 7. Applicants believe the rejection of the Examiner has been overcome. Applicants have deleted the phrase cited by the Examiner from Claim 1 and have specified in Claim 7 that it is the groups Component (B) that can be unesterified -OH groups. Applicants respectfully request the Examiner to withdraw this rejection.

Claim Rejections - 35 USC § 102

Claims 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashiuchi (US 5 900 456). The Examiner states that Hashiuchi discloses a composition comprising an organopolysiloxane represented by formula (1) and waxes such as paraffin wax, microcrystalline wax. (col. 2, lines 4-19, col. 3, lines 19-45) The organopolysiloxane is further exemplified in examples. The Examiner argues that since the paraffin reads on that of Applicants', both should possess the same properties, such as melting point and polydiorganosiloxane fluid miscibility, etc. The Examiner notes that "foam control" in the preamble of the instant claim is merely an intended use, and does not carry any weight of patentability. See MPEP 2111.02.

Applicants have canceled Claim 12 and Claim 13 now depends from Claim 1. Applicants believe that the rejection of the Examiner has been rendered moot. Applicants respectfully request the Examiner to withdraw this rejection.

Claims 1, 3 and 10-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Dickinson (GB 1 523 957). The Examiner argues that Dickinson discloses a granular or aqueous emulsion-based foam control composition comprising a polydiorganosiloxane containing radicals such as ethyl, propyl, octyl, tetradecyl, phenyl, benzyl, 2-phenylpropyl, etc., waxes such as polyethylene wax (a paraffin wax), microcrystalline wax, etc. having specific melting points, a silica or aluminum oxide and an emulsifying agent such as polyoxyethylene distearate. (page 1, line 21 to page 2, line 28 and Examples) An MQ resin with a specific M to Q unit-ratio can be present, (page 2, lines 15-17 and Examples) Since the silica is compounded in the presence of the ingredients such as the polysiloxanes and/or the MQ resin, it is inherently surface-modified in-situ. The amount of the wax and emulsifying agent (i.e., additive composition) is described in

page 2, lines 52-65. The granulated foam control agent is prepared by utilizing the foam control composition supported on a particulate carrier such as sodium tripolyphosphate, etc. in non-aqueous liquid form, (page 2, lines 29-43 and Examples).

Dickinson fails to disclose the foam control composition as now recited in Claims 1-5, 7-11, 13, 15-17, and 19, as amended, and newly added Claims 23-26, of the present invention.

Nowhere in Dickinson is a foam control composition comprising a polydiorganosiloxane fluid, a hydrophobic filler dispersed in the polydiorganosiloxane fluid, and the additive composition of Claim 1 and claims depending therefrom disclosed or taught. Furthermore, nowhere in Dickinson is it taught that when Component (A) as recited in Claim 1, is a diol or a triol at least 90% of the hydroxyl groups of the polyol are esterified, and that when Component (A) is a higher polyol at least 70% of the hydroxyl groups of the polyol are esterified. Furthermore, nowhere in Dickinson is it disclosed that that a mixture of foam control agent (i) and additive composition (ii) is deposited onto a particulate carrier in non-aqueous liquid form.

Therefore, the applicants request that the rejection under 35 U.S.C. §102(b) be withdrawn and the claims allowed to issue.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid (US 6 610 752) in view of L'Hostis (EP 1 075 863). The following column and line numbers of L'Hostis is based on its U.S. equivalent, US 6 521 587. For Claims 1-15 and 17-20, Schmid discloses a granular foam control composition comprising a polydiorganosiloxane containing methyl, ethyl, propyl, butyl and phenyl groups, a microfine silanized silica, a polyol ester such as the esters of glycerol and palmitic acid (typically containing a mixture of glycerol mono, di-, and tri- a Imitate), etc., a bisamide, a fatty acid, a microcrystalline paraffin wax. (col. 2, line 34 to col. 5, line 56 and Examples) The granular foam control composition can be prepared according the method described in col. 3, line 19 to col. 4, line 13, col. 5, line 57 to col. 7, line 67 and Examples. Schmid is silent on a) the polydiorganosiloxane where the substituents have the claimed mean number of carbon atoms, the claimed long chain alkyl group or the claimed X-Ph moiety; and b) a silicone resin. L'Hostis teaches the use of in a foam control composition a polyorganosiloxane and a silicone resin that read on the claimed ones. The motivation of using the specific polyorganosiloxane and the silicone resin is to afford a granular

foam control composition with enhanced foam control efficiency, (col. 2, lines 46-51, col. 2, line 64 to col. 3, line 46, col. 4, line 64 to col. 5, line 28 and col. 7, line 65 to col. 8, line 35) In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize L'Hostis' polyorganosiloxane and silicone resin in Schmid's composition with expected success. Especially, L'Hostis is in the same field as that of Schmid's endeavor. For Claim 16, Schmid is silent on the microfine silanized silica having the claimed average particle size. However, L'Hostis teaches that it is well known to use hydrophobic fillers such as silica with particle size of 0.5 to 50 microns for foam control agents. The silica is well known and is commercially available, (col. 6, line 60 to col. 7, line 28) As such, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize L'Hostis' silica filler in Schmid's composition because Schmid's silica is microfine and the commercial availability of L'Hostis' silica. Especially, L'Hostis is in the same field as that of Schmid's endeavor, and Applicants do not show the criticality of the particle size.

Applicants believe that through the present amendment, the invention as now recited in the Claims is nonobvious over Schmid et al. and L'Hostis. Claim 1 now recites a granulated foam control composition comprising: (i) a foam control agent comprising a polydiorganosiloxane fluid; a hydrophobic filler dispersed in the polydiorganosiloxane fluid; and optionally an organosilicon resin; and (ii) an additive composition having a melting point of at least 35°C comprising a non-polar polyol ester (A) which is a polyol esterified by carboxylate groups each having 7 to 36 carbon atoms, wherein for a diol or a triol at least 90% of the hydroxyl groups of the polyol are esterified, and for higher polyols at least 70% of the hydroxyl groups of the polyol are esterified; and up to 50% by weight of a component (B) which is miscible with component (A) and contains groups more polar than the carboxylate ester groups of the polyol ester (A); wherein the foam control agent (i) and the additive composition (ii) are supported on a particulate carrier with the proviso that a mixture of (i) and (ii) is deposited onto the particulate carrier in non-aqueous liquid form.

Schmid et al fails to disclose or suggest the foam control composition as now recited in Claims 1-5, 7-11, 13, 15-17, and 19, as amended, and newly added Claims 23-26, of the present invention. Nowhere in Schmid et al is the granulated foam control composition as currently

recited Claim 1 and claims depending therefrom disclosed or taught. Schmid et al supplies no apparent reasoning as to why a person of ordinary skill in the art would combine the disclosure of Schmid et al. with L'Hostis to arrive at the Applicants invention as currently claimed in Claims 1, et. seq. Furthermore, even if the disclosures of Schmid et al. and L'Hostis are combined the instant invention is not arrived at.

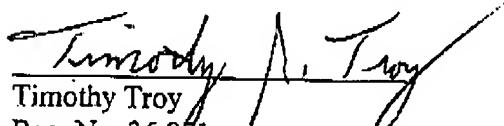
To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to arrive at the claimed invention and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure (MPEP §2143).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art MPEP §2143.03. All words in a claim must be considered in judging the patentability of that claim against the prior art MPEP §2143.03. If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious MPEP §2143.03. The Examiner has not shown that all the claim limitations in Claim 1 and Claims depending therefrom, and newly drafted Claims 23-26 are taught or suggested in Schmid et al nor is there any apparent reason for one skilled in the art to modify Schmid et al and L'Hostis to arrive at Applicants' invention as presently claimed. Furthermore, as stated above, even if the disclosures of Schmid et al. and L'Hostis are combined the instant invention as recited in the Claims above is not arrived at.

Therefore, the applicants request that the rejection under 35 U.S.C. §103 be withdrawn and the claims allowed to issue.

Applicants also submit herewith a petition for a two (2) month extension of time. You are authorized to charge deposit account 04-1520 for any fees necessary to maintain the pendency of this application. You are authorized to make any additional copies of this sheet needed to accomplish the purposes provided for herein and to charge any fee for such copies to deposit account 04-1520.

Respectfully Submitted,
Dow Corning Corporation



Timothy Troy
Reg. No. 36,951
Tel: 989-496-5533

Page 15 of 15